

REMARKS/ARGUMENTS

Status of the Claims

Claim 27 has been allowed.

Claims 2, 11, and 17 are objected to for being dependent upon a rejected base claim. The Office Action indicates that these claims would be allowable if rewritten in independent form including all of the limitations of the rejected base claim and any intervening claims.

Claims 1, 3-10, 12-15, 18-20, and 23-26 stand rejected as explained in detail below.

Claim 1 has been amended to include all of the limitations of claim 2, and claim 2 has been cancelled. Applicants have amended claim 1 in the interest of expediting prosecution of the instant application and not to limit the scope of their claimed invention. Because amended claim 1 now includes all the of the limitations of dependent claim 2 and the Examiner has indicated that claim 2 would be allowable if rewritten in independent form, Applicants submit that claim 1 and claims depending therefrom are in a form ready for allowance.

New claim 28 has been added. This new claim is equivalent to claim 11 rewritten in independent form including all of the limitations of the rejected base claim 1 (prior to the amendment of claim 1 herein). Because claim 11 depends directly from claim 1, there are no intervening claims. Because new claim 28 now includes all the of the limitations of claim 1 and dependent claim 11 and the Examiner has indicated that claim 11 would be allowable if rewritten in independent form, Applicants submit that new claim 28 is in a form ready for allowance.

Claim 10 has been cancelled without prejudice or disclaimer in the interest of interest of expediting prosecution of the instant application and not to limit the scope of Applicants' claimed invention.

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Applicants expressly reserve the right to file one or more continuing applications or take such other appropriate measures deemed necessary to protect the full range of subject matter disclosed in the original claims and specification.

No new matter has been added by way of the amendment of claim 1 or by the addition of new claim 28.

Claims 1, 3-9, 11-15, 17-20, and 23-28 are pending.

Reexamination and reconsideration of the application as amended are respectfully requested in view of the following remarks.

Claim 26 Should Have Been Allowed

On page 8 of the Office Action dated September 27, 2007, the Examiner stated the following:

17. Claim 2 is objected to as being dependent upon a rejected base claim, but would otherwise have been allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

In response to this finding of the Office Action dated September 27, 2007, Applicants presented new independent claim 26 in their response dated January 16, 2008. As discussed in the last paragraph on page 17 of that prior response, new independent claim 26 is identical in scope to the version of claim 2 that was pending at the time of the Office Action dated September 27, 2007 and does not include the subject-verb disagreement that caused the Examiner to object to the prior version of claim 2.

In the instant Office Action, the Examiner has rejected claim 26 under 35 U.S.C. §§ 102 and 103. The Examiner, however, fails to provide any specific explanation as to

why claim 26 was rejected when this claim is drawn to subject matter that the Examiner previously determined to be free of the prior art.

Applicants respectfully request the Examiner either (i) to withdraw the rejections of claim 26 under 35 U.S.C. §§ 102 and 103 and to allow this claim, or (ii) to state with particularity in the next, non-final Office Action why the subject matter of claim 26 is not free of the prior art so as to afford Applicants with an initial opportunity to respond to the grounds for rejecting this claim.

The Rejections of the Claims Under 35 U.S.C. § 112, Second Paragraph Should Be Withdrawn

Claim 10 remains rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter of the invention. Claim 10 has been cancelled. New claim 28 has been added. This rejection is now moot due to the cancellation of claim 10 and should not be applied to the newly added claim.

The Rejections of the Claims Under 35 U.S.C. § 102 Should Be Withdrawn

Claims 1, 3-8, 12, 14-15, 18-20, 23-24, and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Herz *et al.* (WO 02/055651). Claim 1 has been amended. New claim 28 has been added. This rejection is respectfully traversed and should not be applied to newly added claim 28.

In response to the Office Action dated September 27, 2007, Applicants amended claim 1 to add all of the limitations of dependent claim 16 to bring this claim to a form that the Examiner had indicated would be allowable. In particular, the Examiner stated on page 8 of the Office Action dated September 27, 2007:

15. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would otherwise be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Because claim 16 depends directly from claim 1, there are no intervening claims between claim 16 and claim 1. Accordingly, claim 1 as amended in Applicants' response dated January 16, 2008 has a scope that is identical to the scope of claim 16 and thus, is drawn solely to subject matter that the Examiner stated in the Office Action dated September 27, 2007 as being "free of the prior art" (p. 6).

In the instant Office Action (dated July 2, 2008), the Examiner alleges that claim 1 is anticipated by Herz *et al.*, asserting that Applicants' amendment of claim 1 in their response to Office Action dated September 27, 2007 and the arguments therein are not persuasive. Given that Applicants amended claim 1 to be directed to subject matter that the Examiner indicated as being "free of the prior art . . .", Applicants did not believe that any persuasion was necessary. Office Action dated September 7, 2007, p. 6. In the instant Office Action, the Examiner now asserts that claims 1, 3-8, 12, 14-15, 18-20, 23-24, and 26 are anticipated by Herz *et al.* because "[t]here is no requirement in the claims that the second sequence is introduced first; thus, either sequence can be the first and either the second." Office Action dated July 2, 2008, p. 4.

In the instant response, Applicants have again amended claim 1 to be directed to subject matter that the Examiner has indicated as being free of the prior art. Independent claim 1 has been amended to add all of the limitations of dependent claim 2, now cancelled. Dependent claim 2 does not stand rejected under 35 U.S.C. § 102(b) as being anticipated by Herz *et al.* Furthermore, on page 7 of the Office Action dated July 2, 2008, the Examiner indicates that "[c]laim 2 is free of the prior art" Accordingly, Applicants submit that amended claim 1 and dependent claims 3-8, 12, 14-15, 18-20, and 23-24 are not anticipated by Herz *et al.*

Furthermore, Applicants submit that claim 26 is not anticipated by Herz *et al.* As discussed above, new claim 26 is identical in scope to the version of claim 2 that was pending at the time of the Office Action dated September 27, 2007. In that prior Office

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Action, claim 2 was not rejected as being anticipated by Herz *et al.* In the instant Office Action, the Examiner has included claim 26 in the rejection of the claims under 35 U.S.C. § 102(b) as being anticipated by Herz *et al.* The Examiner, however, fails to state any specific reason why claim 26 is anticipated by Herz *et al.*

Applicants respectfully invite the Examiner either (i) to withdraw the rejection of claim 26 under 35 U.S.C. § 102(b) and to allow this claim, or (ii) to state with particularity in the next, non-final Office Action why the subject matter of claim 26 is anticipated by Herz *et al.*

New claim 28 is not anticipated by Herz *et al.* This new independent claim is identical in scope to pending claim 11, a claim which does not stand rejected under 35 U.S.C. § 102(b) as being anticipated by Herz *et al.*

In view of the amendments and remarks, it is submitted that the rejection of claims 1, 3-8, 12, 14-15, 18-20, 23-24, and 26 under 35 U.S.C. § 102(b) should be withdrawn and should not be applied to newly added claim 28.

The Rejections of the Claims Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 1, 3-10, 12-15, 18-20, and 23-26 are rejected under 35 U.S.C. § 103(a). Claims 1, 3-9, 12-15, 18-20, and 23-26 are rejected as being unpatentable over Herz *et al.* (WO 02/055651). Claims 1, 3-10, 12-15, 18-20, and 23-26 are rejected as being unpatentable over Herz *et al.* (WO 02/055651) in view of Maliga *et al.* (1995, U.S. Patent No. 5,451,513). Claim 1 has been amended. Claim 10 has been cancelled. New claim 28 has been added. This rejection is respectfully traversed and should not be applied to the newly added claim.

As discussed above, Applicants have amended claim 1 in response to the Office Action dated September 27, 2007 to add all of the limitations of dependent claim 16 to bring this claim to a form that the Examiner previously indicated was free of the prior art. In the instant Office

Action, the Examiner has recanted this finding and now alleges that the subject matter of claim 1 is unpatentable over both Herz *et al.* and the combination of Herz *et al.* and Maliga *et al.*

In the instant response, Applicants have again amended claim 1 to be directed to subject matter that the Examiner has indicated as being free of the prior art. Independent claim 1 has been amended to add all of the limitations of dependent claim 2, now cancelled. Dependent claim 2 does not stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Herz *et al.* or Herz *et al.* in view of Maliga *et al.* Accordingly, Applicants submit that amended claim 1 and dependent claims 3-9, 12-15, 18-20, and 23-25 are not obvious in view of Herz *et al.* or the combination of Herz *et al.* and Maliga *et al.*

Furthermore, Applicants submit that claim 26 is not obvious in view of Herz *et al.* or the combination of Herz *et al.* and Maliga *et al.* As discussed above, new claim 26 is identical in scope to the version of claim 2 that was pending at the time of the Office Action dated September 27, 2007. In that prior Office Action, claim 2 was not rejected under 35 U.S.C. § 103(a) as being unpatentable over either Herz *et al.* or Herz *et al.* in view of Maliga *et al.* In the instant Office Action, the Examiner has included claim 26 in the rejection of the claims under 35 U.S.C. § 103(a) as being unpatentable over either Herz *et al.* or Herz *et al.* in view of Maliga *et al.* The Examiner, however, fails to state any specific reason why claim 26 is unpatentable over either Herz *et al.* or Herz *et al.* in view of Maliga *et al.*

Applicants respectfully invite the Examiner either (i) to withdraw the rejection of claim 26 under 35 U.S.C. § 103(a) and to allow this claim, or (ii) to state with particularity in the next, non-final Office Action why the subject matter of claim 26 is obvious in view of the cited references.

New claim 28 is not obvious in view of Herz *et al.* or the combination of Herz *et al.* and Maliga *et al.* This new independent claim is identical in scope to pending claim 11, a claim which does not stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Herz *et al.* or Herz *et al.* in view of Maliga *et al.*

In view of the amendments and remarks, it is submitted that the rejection of claims 1, 3-9, 12-15, 18-20, and 23-26 under 35 U.S.C. § 103(a) should be withdrawn and should not be applied to newly added claim 28.

The Objections to the Claims Should Be Withdrawn

Claims 2, 11, and 17 are objected to as being dependent upon a rejected base claim, claim 1. The Examiner states that these claims would be acceptable if rewritten in independent form.

Applicants have cancelled claim 2, and claim 1 has been amended to incorporate all of the limitations of claim 2. Accordingly, Applicants submit that claim 1 is ready for allowance.

Applicants have provided new independent claim 28, which claims the subject matter of pending claim 11. Accordingly, Applicants submit that claim 28 is ready for allowance.

Claims 11 and 17 remain pending. Because claim 1 has been amended to a form that the Examiner has indicated in the instant Office Action as being allowable. Applicants submit that the objections to claims 11 and 17 should be withdrawn because the amendments to claim 1 overcome the rejections under 35 U.S.C. §§ 102(b) and 103(a).

CONCLUSION

In view of the above amendments and remarks, Applicants submit that the objections to the claims and the rejections of the claims under 35 U.S.C. §§ 102, 103, and 112, second paragraph, are overcome. Applicants respectfully submit that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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